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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,234	04/18/2001	David Klug	88265-4026	1401

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EXAMINER

TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,234

Applicant(s)

KLUG ET AL.

Examiner

Lien T Tran

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 10, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The process in claim 23 is not supported by the original disclosure. There is no disclosure in the specification that a portion of the mass flows to conform to the shape of the sugar wafer". Whether the mass will flow to conform to the shape depends on factors such as the viscosity of the mass and the shape of the wafer. The specification does not disclose anything about modifying the viscosity and the shape of the wafer to cause the mass to flow and conform to the shape. There is also no disclosure of the shape being sufficiently solid under ambient temperature or the confectionery mass being harden under ambient condition. The limitation of claim 22 is not found in the specification. The specification does not disclose any temperature with respect to the confectionery mass.

In the response filed Jan. 21, 2004, applicant traverses the 112 first paragraph rejection. Applicant comments that the office action appears to mistake the wafer itself as being the mass that is flowing and conforming. It is believed applicant takes some of the sentences in the rejection out of context. The office action states that "whether the mass will flow to conform to the shape depends on factors such as the viscosity of the mass and the shape of the wafer". The viscosity is referred to the mass, not the wafer. The examiner is well aware from reading the specification that the wafer is not the mass

Art Unit: 1761

that is flowing and conforming. Applicant argues that it is clear that a portion of the mass flows to conform to the sugar wafer since the mass is added in molten. This argument is not persuasive. A molten material will not necessarily flow to conform to a specific shape. For instance, a material might be molten but have a high viscosity and thus might not flow to fill a specific shape or a material might be molten but is very fluid and might not flow to fill a specific shape. Furthermore, the shape of the product also defines if the material will flow to conform to the shape. If a liquid material is poured onto a flat shape, the material will not flow to conform to the shape. The use of the term molten in the specification does not provide supported for what is being claimed.

Applicant has not demonstrated that all molten material will flow to conform to a shape.

Applicant states the burden is on the office to demonstrate lack of possession of the invention in the claim terms. The examiner is not aware of this requirement. It is a question of support in the original specification; the specification either discloses it or it does not. In the instant situation, applicant has not pointed out the portion of the specification that would support such limitation. Applicant comments that the office action ignores the Couzens Declaration. The declaration was properly considered in the previous office action and was not found to be persuasive. Applicant argues the language "ambient conditions" is well understood. The question is not whether the term is well understood; the question is whether applicant discloses such limitation in the specification and applicant has not pointed out the support. Applicant argues that applicants have simply reworded features specifically disclosed in the specification.

What features is applicant rewording? The specification does not disclose anything

concerning ambient conditions or ambient temperature. Applicant argues that no special temperature is disclosed; thus, the conventional understanding is that this hardening can and would result under ambient temperature. Applicant has not provided any evidence to support this argument. There is no authoritative text to show that when no temperature is disclosed, the conventional understanding is ambient temperature. Applicant does not disclose in the specification that when no temperature is indicated, then ambient temperature is used. The statement made by applicant that "a creamy molten material will indeed flow to conform to even a flat wafer" is not supported by evidence.

Claims 1 and 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti et al in view of Boehm et al.

Conti et al disclose sugar wafers. The wafers may have a variety of shapes and sizes e.g.; they may be flat sheets, cup, cone-shaped, or tubular. They may be used in a variety of confectionery products together with confectionery materials such as chocolates or other fatty material such as fat-based cream. A moisture barrier may be used between the surface of the sugar wafer and the other confectionery material; the barrier is preferably chocolate or chocolate substitute. The confectionery material preferably has a low water activity of below .3. Example I discloses the wafer tube is filled with a fat-based cream containing yoghurt. The wafer product may be enrobed with another suitable confectionery material such as plain, white or milk chocolate or with chocolate substitute. (See pages 4-5)

Conti et al do not disclose the size, the step of allowing the confectionery to harden, the inclusion of edible inclusions, the amount and type of vegetable fat in combination with chocolate and the material being solid or harden under ambient temperature.

Boehm et al disclose a filled cookie which contains an oil based interior filling. The oil filling contains nut paste in combination with chocolate. (see col. 6 lines 1-10)

It would have been obvious to one skilled in the art to use any type of filling material in the wafers disclosed by Conti et al. The types of filling material that are used vary among individual depending on the flavor, taste, texture etc... desired. The filling material claimed is known in the art as shown by Boehm et al; it would have been obvious to one to use such filling if such taste is wanted. As to the filling being solid under ambient condition, this condition varies with the different type of filling and can be readily determined by one skilled in the through routine experimentation. If the product will be stored under ambient condition and a solid filling is desired, it would have been obvious to make a filling which is solid under ambient condition. It would also have been obvious to allow the confectionery material to harden if a solid mass is desired. For example, if one desires the taste of a solid mass, it would have been obvious to allow the confectionery material to harden or if one wants the taste of a liquid confectionery, it would have been obvious to do the opposite. It would have been obvious to make the product in any size because Conti et al teach the sugar wafers may have a variety of sizes. It would also have been obvious to add edible inclusions to give extra taste and flavor. As to allowing the confectionery material to take the shape of the

wafer, it would have been obvious to one skilled in the art to adjust parameters, such as viscosity, temperature at which the material is filled into the wafer, the amount of filling material and the shape of the wafer, to allow the filling material to take the shape of the wafer when such design is wanted. It would also have been obvious to make the confectionery material to have a dome shape to give the look of an ice cream to enhance the novelty of the product since Conti et al disclose the wafer may have a cone-shape and cone shape wafer is commonly associated with ice cream.

In the response filed Jan. 21, 2004, applicant argues Conti teaches a different food product from Boehm; thus, one would have had no motivation to combine the fillings of Conti with those of Boehm. The Boehm reference is relied upon only for the teaching of the fat-based confectionery material. Conti teaches that a variety of confectionery products such as ice creams, chocolate or fat-based cream can be used together with the wafer. Thus, it would have been obvious to use any known confectionery cream depending on the taste, flavor desired. Applicant further argues Boehm requires the presence of both oil-based filler and water-based filler in the cookie. The Boehm reference is relied upon only to show that a fat-based confectionery material as claimed is known. Conti does not require the presence of both fillers. The oil-based filler disclosed by Boehm is a fat-based cream and it would have been obvious to use such cream in the Conti product. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Conti does not require a

Art Unit: 1761

combination of confectionery product; thus, it would not have been obvious to put a combination of confectionery product in the Conti product. Conti teaches the use of a fat-based cream; thus, it would have been obvious to use just the fat-based cream when using the teaching of Boehm. Boehm et al teach to use a combination of filling materials to obtain a special effect; if such effect is not wanted, it would not have been obvious to use both filling materials. There is no indication in Boehm et al that the fillings can not be used alone; thus, there is reasonable expectation of success.

Applicant's arguments filed Jan. 21, 2004 have been fully considered but they are not persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Tuesday, Wednesday and Friday.

Application/Control Number: 09/837,234
Art Unit: 1761

Page 8

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 26, 2004

Lien Tran
LIEN TRAN
PRIMARY EXAMINER
Group 1700